

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed May 4, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **Claim Rejections - 35 USC § 101**

Claims 1, 2, 4, 8-11, 15-19 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

In response to the rejection, claim 1 has been amended to describe a computer implementation. In view of this amendment, Applicant respectfully submits that claim 1 comprises no non-statutory subject matter.

Regarding claim 16, Applicant respectfully submits that the originally-claimed “computer readable medium” and the various recited “logic” satisfy the requirements of 35 U.S.C. § 101. Applicant therefore respectfully requests that the rejection be withdrawn as to claim 16.

### **Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1-6, 8-13, and 15-19 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Helperich (“Helperich,” U.S. Pat. No. 6,636,733). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration.” W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must

be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Helferich reference. Referring first to claim 1, recited is (emphasis added):

1. A method for controlling the presentation of advertisements, the method being practiced by a local computing device having a processing device and a memory, the method comprising:

*receiving local weather condition information from a sensing unit that is separate from the computing device;*

*determining* which advertisements are appropriate for presentation *using the local computing device* and based upon the received weather condition information; and

*facilitating presentation of appropriate advertisements on a local display unit.*

As a first matter, Helferich does not teach or suggest “receiving local weather condition information from a sensing unit that is separate from the computing device” as provided in claim 1. Instead, Helferich only teaches sensors that are “added to the mobile phone.” Helferich, column 10, lines 5-6. Applicant further notes that it would not have been obvious to a person having ordinary skill in the art to collect conditions information using a separate sensing unit from Helferich’s disclosure given that such a modification would reduce or negate the “mobility” of the mobile phone. Indeed, a person having ordinary skill in the art would be motivated against such a modification.

As a second matter, Helferich does not teach or suggest “determining which advertisements are appropriate for presentation using the local computing device” as is also provided in claim 1. To the contrary, Helferich’s mobile phone senses a local

temperature and transmits that local temperature to an email server 16, which sends an email message containing an advertisement back to the mobile phone. Helperich, column 10, lines 5-15. Accordingly, for Helperich to satisfy Applicant's claim language, the "computing device" (i.e., Helperich's mobile phone) would need to make the advertisement determination. No such teaching or suggestion is provided by Helperich.

Referring next to claim 16, Applicant recites as follows (emphasis added):

16. Advertisement presentation control software *stored on a computer readable medium of a local computing device*, comprising:  
*logic configured to collect local weather condition information from a sensing unit that is separate from the local computing device;*  
*logic configured to determine which advertisements are appropriate for presentation based upon the collected weather condition information; and*  
*logic configured to transmit appropriate advertisements to a display unit that is separate from the local computing device.*

As an initial matter, Helperich does not teach or suggest "advertisement presentation control software stored on a computer readable medium of a local computing device". Instead, any such software is, if at all, stored on a remote email server. See Helperich, column 10, lines 5-15.

In addition, Helperich does not teach or suggest "logic configured to collect local weather condition information from a sensing unit that is separate from the local computing device". First, no such "collecting" logic is provided on Helperich's "local computing device" (i.e., the mobile phone). Second, Helperich's "local computing device" is not separate from the display unit (i.e., the display screen is provided on the mobile phone).

Furthermore, Helferich does not teach or suggest “logic configured to determine which advertisements are appropriate for presentation based upon the collected weather condition information”. No “determining” logic is provided on Helferich’s “local computing device (i.e., the mobile phone). Any such logic, if at all, resides on Helferich’s remote email server.

Moreover, Helferich does not teach or suggest “logic configured to transmit appropriate advertisements to a display unit that is separate from the local computing device”. First, Helferich’s “local computing device” does not transmit any advertisements because the display is actually part of the device. Second, the display device is not separate from the “local computing device.”

Turning to the dependent claims, several of the dependent claims comprise limitations that are not found in the Helferich disclosure. For example, in regard to claims 8 and 19, Helferich does not disclose that the “local computing device” determines the current local time or determines the advertisements based upon that local time.

Due to these shortcomings of the Helferich reference described above, Applicant respectfully asserts that Helferich does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

#### **Claim Rejections - 35 U.S.C. § 103(a)**

Claims 7 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Helferich. Claim 14 has been canceled and therefore the rejection is moot as to that claim. Applicant respectfully traverses this rejection as to claim 7.

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a

proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). It is respectfully asserted that no such case has been made in the outstanding Office Action.

As described above, Helferich is deficient as to several limitations as to Applicant's independent claim 1. Given that claim 7 depends from claim 1, claim 7 is allowable at least for the same reasons that claim 1 is allowable.

With regard to the particular subject matter recited in claim 7, Applicant notes that Helferich provides no teaching or suggestion whatsoever for a "display unit is mounted to a fuel pump". Helferich's disclosure is described in the context of a mobile phone. There simply is no reason that a person having ordinary skill in the art would be motivated to implement the Helferich's system on a fuel pump in view of Helferich's disclosure. Moreover, Applicant objects to the statement of the rejection as failing to state a *prima facie* case for obviousness. As is expressed by the Manual of Patent Examining Procedure (MPEP) in section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

The statement that "It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included presentation of ads is on a display mounted to a fuel pump in order to achieve the above mentioned advantage" is a mere conclusion without any explanation. The Office Action has identified no suggestion or motivation that would explain *why* Applicant's claim would have been obvious in view of the applied reference.

In summary, it is Applicant's position that Applicant's claim 7 is not obvious in view of Helferich. Therefore, it is respectfully requested that the rejection of this claim be withdrawn.

### **Canceled Claims**

As identified above, claims 2-5, 10-15, and 18 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

### **New Claims**

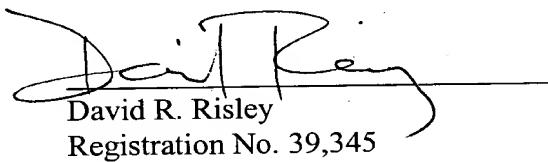
As identified above, claims 20-30 have been added into the application through this response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

With specific reference to claims 26 and 29, Applicant notes that Helferich is silent as to controlling advertisements relative to local weather forecast information.

## CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

7-8-04

Mary Meegan  
Signature